



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,956	03/06/2002	Robert G. Gaito	ICEN-0001	8393

23550 7590 05/15/2006

HOFFMAN WARNICK & D'ALESSANDRO, LLC  
75 STATE STREET  
14TH FLOOR  
ALBANY, NY 12207

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,956	<b>Applicant(s)</b> GAITO, ROBERT G.	
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3, 6-13, and 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim et al.**
3. As per **independent Claim 1**, Grim discloses a method of generating a target list, comprising: creating a contact database having a plurality of contacts, wherein each contact has a unique identifier (pgs.7-8, CARMA client profile data); querying a history database (DSS Data) for each contact using the unique identifier (Pg.8); determining a set of history attributes (lead data) for each contact based on the query; and generating the target list from the contact database based on at least one history attribute (pgs.7-8, CLR lead records generated by matching CARMA client profile data with specified DSS lead data).
4. As per Claim 2, Grim discloses updating the history database based on the target list (pg.3, feedback used to update client profiles).
5. As per Claim 3, Grim discloses wherein the creating step includes: providing a plurality of input lists, each input list having a plurality of input contacts (pgs.5-6, internal and external data sources); associating a unique identifier to each input contact that does not

have a unique identifier (pg.6, unique identifier); determining a set of unique input contacts in the input lists; and adding each unique input contact to the contact database (pg.6, creating and updating CARMA client profile data).

6. As per Claim 6, Grim discloses wherein the associating step includes: providing a stored contact database having a plurality of stored contacts, wherein each stored contact has a unique identifier (pgs.7-8, CARMA client profile data); determining whether each input contact matches any stored contact; using a unique identifier for a stored contact for each input contact that matches the stored contact; and generating a unique identifier for each input contact that does not match any stored contact (pg.10, adding new client profiles to database).
7. As per Claim 7, Grim discloses wherein the associating step further includes adding each input contact that does not match any stored contact to the stored contact database.
8. As per Claim 8, Grim discloses wherein the creating step includes: providing a suppress list, having a plurality of suppress contacts; and ensuring that each suppress contact does not appear on a contact list (removal list).
9. As per Claim 9, Grim discloses wherein the determining step includes: identifying a previous target list generated by a plurality of previous input lists; determining whether each contact appeared on the previous target list; and determining, for each contact that appeared on the previous target list, a number of previous input lists on which the contact appeared.
10. As per Claim 10, Grim discloses wherein the generating step includes: identifying a previous target list; creating a contact management report based on the contact database

and the previous target list; selecting at least one group of contacts having a common history attribute based on the contact management report; and adding each contact in the at least one group of contacts to the target list.

11. As per **independent Claim 11**, Grim discloses a system for generating a target list (lead records) from a plurality of input lists, each input list having a plurality of input contacts, comprising: an identification system for associating a unique identifier to each input contact (pg.6); a merge system for processing the plurality of input lists to generate a contact database having a plurality of contacts (pgs.6-7, CARMA client profile data); a history system for determining a set of history attributes for each contact by querying a history database for each contact using the unique identifier (pgs.7-8, DSS Data); and a target system for generating the target list based on the contact database and at least one history attribute (pgs.7-8, lead records generated by matching CARMA client profile data with specified DSS lead data).
12. As per Claim 12, Grim discloses an update system for updating the contact history database based on the target list (pg.3, feedback used to update client profiles).
13. As per Claim 13, Grim discloses a report system for generating a contact management report based on the contact database and a previous target list, wherein the target list is further based on the contact management report (pg.3, feedback used to update CARMA client profile data which is used to generate new lead records in a cyclical pattern).
14. As per **independent Claim 16**, Grim discloses a contact management report based on a contact database and a previous target list, wherein the contact database includes a plurality of contacts merged from a plurality of input lists (pgs.7-8, CARMA client

profile data), and wherein the previous target list includes a plurality of target contacts merged from a plurality of previous input lists (pgs.7-8, CLR lead records), comprising: input list data that describes at least one attribute of each input list (pgs.7-8, CARMA client profile data); previous target list data that describes at least one attribute of the previous target list (pgs.7-8, CLR lead records); group data that describes one of a group of contacts and a group of target contacts having a common history attribute (pgs.7-8, CLR lead records generated by matching CARMA client profile data *with specified DSS lead data*); and comparison data that describes at least one history attribute of a group of contacts that match a group of target contacts and appear on both an input list and the previous target list (pg.3, generating new marketing leads based on past contacts and lead record results).

15. As per Claim 17, Grim discloses wherein the input list data includes a number of contacts obtained from an input list (pgs.7-8, CARMA client profile data generated from inputs).
16. As per Claim 18, Grim discloses wherein the previous target list data includes a number of target contacts that appear on an input list.
17. As per Claim 19, Grim discloses wherein the group data includes a number of contacts that appear on a single input list (operational possibility of Grim system).
18. As per Claim 20, Grim discloses wherein the group data includes a number of the group of contacts that appear on multiple input lists (operational possibility of Grim system).
19. As per Claim 21, Grim discloses wherein the comparison data includes a number of the group of contacts that appear on a single input list and a plurality of previous input lists (operational possibility of Grim system).

20. As per Claim 22, Grim discloses wherein the comparison data includes a number of contacts that appear on a plurality of input lists and a plurality of previous input lists (operational possibility of Grim system).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 22. Claims 4, 5, 14, and 15 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Grim.**

23. As per Claim 4, Grim does not expressly show wherein the creating step further includes determining a number of input lists on which each unique input contact appears.

24. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method of generating a target list would be performed regardless of whether a number of input lists on which each unique input contact appears was determined or not, because the determination data is never used to further the target list generation process. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

25. As per Claim 5, Grim does not expressly show wherein each input list further includes a priority and wherein the creating step further includes determining an input list having a highest priority on which each contact appeared.
26. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method of generating a target list would be performed regardless if the input list had a priority or whether an input list having a highest priority on which each contact appeared was determined or not, because the determination data is never used to further the target list generation process. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
27. As per **independent Claim 14**, Grim discloses a method of creating a contact management report, comprising: creating a contact database having a plurality of contacts by merging a plurality of input lists (pgs.7-8, CARMA client profile data), wherein each contact includes a unique identifier (pg.8, unique ID)) and a value indicating a number of input lists on which the contact appeared; querying a history database (DSS Data) for each contact in the contact database using the unique identifier (pgs.6-8, matching DSS data with CARMA data); specifying a previous target list based on a plurality of previous input lists (pgs.7-8, CLR lead records); determining a set of history attributes for each contact in the contact database based on the previous target list and the query (DSS lead data that determined lead records); and creating the contact management report based on



the contact database, the previous target list and the set of history attributes (pg.9 result information from targeted campaign fed back into CARMA and DSS databases).

28. Grim does not expressly show a value indicating a number of input lists on which the contact appeared.
29. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method of generating a target list would be performed regardless of whether a value indicating a number of input lists on which the contact appeared was included or not, because the value data is never used to further the target list generation process. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
30. As per Claim 15, Grim does not expressly show wherein the determining step includes determining a number of previous input lists on which each contact appeared.
31. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method of generating a target list would be performed regardless of whether a number of previous input lists on which each contact appeared was determined or not, because the determination data is never used to further the target list generation process. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. The following U.S. patent are cited to further show the best domestically patented prior art found by the examiner:

**U.S. Pat. No. 2002/0004745 A1 to Bascobert et al.**

Bascobert discloses a system for accumulating, modifying, and storing consumer data for target marketing purposes.

34. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**Collie, Shimon Van, "Priming the Profitability Pump." Bank Technology News, January 1999.**

Collie disclosed systems used by banking companies to track customer data and create targeted marketing programs.

35. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

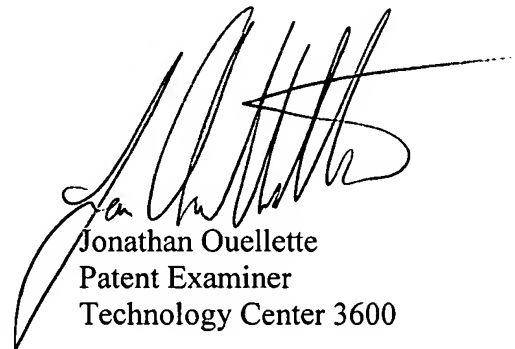
36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-

Art Unit: 3629

6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
38. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

May 11, 2006



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600